

REMARKS
Status of the Application

In the Office Action, Claims 1-2, 4-9 and 11-12 were rejected. In the present Response, claim 1 has been amended so that claims 1-2, 4-9 and 11-12 are pending. No new matter has been added.

Claim 1 has been amended for grammatical and clarity reasons, and not for reasons related to patentability.

Rejection under 35 U.S.C. § 103(a)

Claims 1-2, 4-9 and 11-12 stand rejected under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 4,939,009 to Beavers et al. in view of U.S. Patent No. 5,532,053 to Mueller. The Examiner asserts that “[i]t would have been obvious to one of ordinary skill in the art at the time the invention was made to attach a woven or non-woven substrate of polyolefin or polyester as suggested by Mueller to both sides of the laminate film of Beavers in order to reinforce the film and take advantage of the adhesive properties of the multilayer film to use in various end applications.” The Examiner further asserts that in accordance with column 7, lines 40-50 of Mueller, “[i]t would have been obvious to one of ordinary skill in the art at the time the invention was made to treat the non-woven or woven fabric substrates with a corona treatment as suggested by Mueller when used to reinforce the multilayer film of Beavers motivated by the desire to increase bond strength.”

Specifically, the Examiner asserts that the title and column 1, lines 10-23 of Beavers indicates that “Beavers is directed to a multilayered sheet having excellent adhesion which is useful as a carrier for decorative and protective coating ... applied to substrates.” The Examiner also asserts that “Beavers teaches a laminate comprising a layer of copolyetherester and a layer of polyolefin sandwiching a tie layer (Abstract)”, and that the “tie layer comprises a low molecular weight polyethylene and about 0.1 to about 30 weight percent of vinyl acetate (column 5, lines 9-17).” The Examiner proceeds to equate the copolyetherester layer allegedly disclosed by Beavers with the copolyetherester layer of Applicants’ claimed invention, the polyolefin layer allegedly disclosed by Beavers with the moisture vapor control layer of Applicants’ claimed invention, and the tie layer allegedly disclosed by Beavers with the tie layer of Applicants’ claimed invention.

The Examiner, however, acknowledges that “Beavers fails to teach that a substrate comprising a woven or non-woven material is attached to the moisture vapor control layer as required by claim 1”, and turns to Mueller.

Mueller, the Examiner asserts, “is directed to a high moisture transmission medical film.” The Examiner claims that “Mueller teaches a laminate film that comprises at least one layer formed from a first polyetherester copolymer, a second layer which can consist of an ethylene-vinyl acetate copolymer and a third layer (Abstract)”, and that “Mueller notes that the laminate film can be bonded to one or more layers of polyesters, polyolefins, polyamides and non-woven fabrics (Abstract).” The Examiner further alleges that column 7, lines 28-33 of “Mueller teaches that the non-woven materials can be a polyolefin ... such as polypropylene or polyethylene”, and even though the Examiner proceeds to admit that Mueller does not disclose a specific weight percentage still asserts that the polyolefin containing material implied by Mueller would meet Applicant’s requirements.” The Examiner further claims that “[i]n order to improve bond strength, Mueller teaches that one or both of the non-woven materials used as substrates can be subjected to a corona treatment, or Applicant’s ‘primer’”

The Examiner further admits that “Beavers in view of Mueller does not explicitly teach the claimed MVTR inequality and ratio”, but proceeds to assert that “it is reasonable to presume that the MVTR is inherent to the laminate structure of Mueller in view of Beavers et al.” The Examiner claims that “[s]upport for said presumption is found in the use of like materials and the use of like processes which would result in claimed MVTR inequality and ratio.” The Examiner asserts that “[t]he burden is upon Applicant to prove otherwise”, and cites *In re Fitzgerald*, 205 USPQ 495. The Examiner further asserts that “the presently claimed property of MVTR inequality and ratio would obviously have been present once the Beavers in view of Mueller product is provided”, and cites *In re Best*, 195 USPQ at 433, footnote 4 (CCPA 1977).

Applicants, however, respectfully assert that the Examiner has failed to establish a *prima facie* case of obviousness necessitating withdrawal of this rejection. Section 2142 of the MPEP explains that a *prima facie* case of obviousness is only established when 1) all of the claim limitations are either taught, or suggested by the cited prior art, 2) there is some suggestion or motivation to

modify or combine the cited prior art references, and 3) there is a reasonable expectation of successfully producing the claimed invention via such a combination. Section 2143 further explains “[t]he teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant’s disclosure.”

Applicants, however, respectfully assert that ALL of the limitations of the claimed invention are not taught or suggested by Beavers in view of Mueller. Specifically, Applicants respectfully assert that the MVTR inequality and ratio limitation of claim 1 in neither expressly, which the Examiner has openly admitted, nor inherently disclosed by Beavers or Mueller.

Applicants respectfully assert that although MPEP Section 2112, paragraph IV indicates that the Examiner must provide rationale or evidence tending to show that the laminate of Beavers in view of Mueller inherently possesses the MTVR inequality and ratio set forth in claim 1, the Examiner has failed to provide any such rationale or evidence. Indeed, Section 2112, paragraph IV indicates that

“[t]o establish inherency, the extrinsic evidence ‘must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill. Inherency, however, may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient.’”

Paragraph IV further indicates that “the examiner must provide a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic necessarily flows from the teachings of the applied prior art.” In fact, paragraph IV indicates that “[t]he fact that a certain result or characteristic may occur or be present in the prior art is not sufficient to establish the inherency of that result or characteristic.”

Applicants, however, respectfully assert that many factors affect the MVTR, and therefore the MVTR claimed by Applicants does not necessarily flow from the laminates of Beavers in view of Mueller. Indeed, Applicants expressly indicate at page 7, lines 14-16 of the specification that “[t]he MVTR of each layer is primarily dependent upon the chemical composition of the layer and the thickness of the layer....” Applicants further noted at page 15, line 21 that “[t]he MVTR can be

regulated by various means”, and at lines 21-23 that “[t]he thickness of a layer of copolyetherester has an effect on the MTR in that the thinner the layer the higher the MTR.” Moreover, Mueller expressly indicates at column 6, lines 12-14 and lines 21-23 that “[t]he thickness of the laminate film is determined at least in part by the moisture vapor transmission rate desired”, and that “[t]he formulation of the blend may be varied as needed to form a film having a desired strength and a desired moisture vapor transmission rate.” As a result, the Examiner has simply not asserted anything more than that an MTR_{CAS} that is greater than MTR_{SAC} may occur or be present in the laminates of Beavers in view of Mueller, and such an assertion does not amount to the necessary fact or technical reasoning that must be provided to reasonably support a determination that the $MTR_{CAS} > MTR_{SAC}$ limitation necessarily flows from the laminates of Beavers in view of Mueller.

Moreover, MPEP Section 2112, paragraph V indicates that Applicants do not have the burden to prove that the MTR limitation is not inherent in the laminates of Beavers in view of Mueller until the Examiner presents evidence or technical reasoning tending to show the inherency of the limitation. The Examiner, however, has failed to provide the requisite fact or technical reasoning needed to discharge her burden, and therefore Applicants do not have a burden to prove that the MTR limitation is not inherent in the laminates of Beavers in view of Mueller.

As the Examiner bears the burden of providing the necessary fact or technical reasoning needed to support the asserted inherency of the MTR limitation and no such fact or technical reasoning has been provided, Applicants respectfully assert that Beavers in view of Mueller fails to either expressly, or inherently teach or suggest ALL of the limitations of Applicants’ claimed invention. Accordingly, Applicants respectfully request that the Examiner withdraw this rejection.

Moreover, Applicants respectfully assert that Mueller teaches away from an MTR_{CAS} that is greater than an MTR_{SAC} . That is, Mueller discloses a laminate in columns 3-4 that comprises a first polyetherester copolymer layer, a second layer comprised of a sealant layer material, and a third polyolefin polymer sealant layer, wherein the first layer is sandwiched between the second and third layers. Claim 6 of Mueller further indicates that the non-woven material is attached to the second layer so that the third layer is exposed to the atmosphere. The third layer, however,

blocks the passage of moisture from the atmosphere to the copolyetherester layer so that the directional transfer of moisture as claimed by Applicants cannot exist.

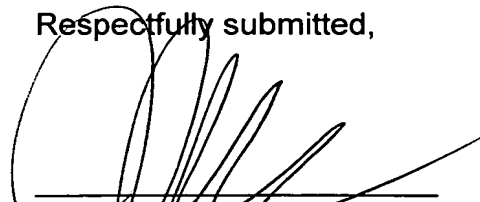
Applicants further direct the Examiner's attention to Example V, wherein Mueller discloses various laminate structures produced in accordance with his invention for attachment to a non-woven material. Applicants note that all of the laminate structures of Example V sandwich the copolyether ester between layers containing sealants so that regardless as to which layer the non-woven is attached, the sealant containing layer blocks the passage of water from the atmosphere to the copolyetherester layer. As a result, Example V of Mueller further indicates that the directional transfer of water claimed by Applicants does not exist in the medical film disclosed by Mueller.

As Mueller teaches away from Applicants' claimed invention, Applicants respectfully assert that there is no reasonable expectation of successfully producing Applicants' claimed invention via such a combination. As a result, Applicants respectfully assert that their claimed invention is not rendered obvious by Beavers in view of Mueller. Accordingly, Applicants respectfully request that the Examiner withdraw this rejection.

Summary

In view of the foregoing amendments and remarks, Applicants submit that this application is in condition for allowance. In order to expedite disposition of this case, the Examiner is invited to contact Applicants' representative at the telephone number below to resolve any remaining issues. Should there be a fee due which is not accounted for, please charge such fee to Deposit Account No. 04-1928 (E.I. du Pont de Nemours and Company).

Respectfully submitted,



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